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09/993,665	11/27/2001	Frampton E. Ellis III	5884.0020-03	1491

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

18

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/993,665

Applicant(s)

ELLIS, III

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

***Amendment Entering New Matter***

1. Applicant's amendment filed January 28, 2004 includes an impermissible shift that is not allowed after applicant has received an Office action on the merits of the originally presented claims. This shift includes new matter which was not present in the application as originally claimed. Applicant went through great lengths to discern between the sole and the midsole in the application. Applicant first claimed the sole having different thicknesses in different areas of the sole and now has amended the claims to make it the midsole having the different thicknesses in the different areas. This is clearly a shift in the invention from the sole to the midsole that is impermissible. Therefore, the claims will be treated as originally present since this shift cannot be allotted as applicant as received an Office action on the merits of the originally filed claims claiming the sole and not the midsole having these thicknesses.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the forefoot region of the sole must be

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shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 21 contains the phrases "a sole forefoot area at a location substantially corresponding to the location of a forefoot of an intended wearer's foot when inside the shoe" and "a sole midtarsal area at a location substantially corresponding to the area between the heel and the forefoot of the intended

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wearer's foot when inside the shoe" which are considered new matter since it was not previously disclosed that the sole extended anywhere into the forefoot area. A sole for a sports shoe does not have to be the entire length of the user's foot, and nowhere in the specification as originally filed has the applicant noted such a length. Figures 15A and D are not described within the specification in the description of the drawings as being located in the forefoot area or being the frontal plane cross-section of the forefoot area and there are no other sectional figures that show where these figures are taken from.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 21-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 21 contains the phrases "a sole forefoot area at a location substantially corresponding to the location of a forefoot of an intended wearer's foot when inside the shoe" and "a sole midtarsal area at a location

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substantially corresponding to the area between the heel and the forefoot of the intended wearer's foot when inside the shoe" which render the claim so. It is not clear from the figures or the specification what forefoot area the applicant is referring to in these phrases as different feet of different people will have the parts of the foot fall in different locations within the same sized shoe. Claim 39 contains the phrase "wherein the frontal plane cross-section is located in a forefoot area of the shoe sole" which renders the claim vague and indefinite. None of the figures, as described by applicant, are taken in the forefoot area of the sole and the sole has not been defined in the specification as having a forefoot area. Therefore, it is unclear as to what area the applicant is referring.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21-34, 37-44 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese reference 39-15597 (JP '597) in view of Norton et al. 4,370,402. JP '597 discloses all the limitations substantially as claimed including the following: (Figure 7, right Figure of the two, of JP '597 is shown unloaded as no foot is shown placed within the shoe. Since the reference numbers in Figure 7 are illegible, the layers of the sole will be numbered from the inside out with the three layers labeled 1-insole, 2-midsole, and 3-outsole. When Figure 7 is cited, it refers to the right figure in Figure 7) a sole inner surface (inner surface of 1); a sole outer surface (outer surface of 3); the sole surfaces defining a sole medial side (left side of shoe of Figure 7), a sole lateral side (right side of shoe sole of Figure 7) and a sole middle portion located between the sides (that portion between the left and right sides in Figure 7); a sole forefoot area at a location substantially corresponding to the location of a forefoot of an intended wearer's foot when placed inside the shoe (see Figure 6); a sole heel area at a location substantially corresponding to the location of a heel on an intended wearer's foot when placed within the shoe (see Figure 6); a sole midtarsal area at a location substantially corresponding to the area between the heel and the forefoot areas (see Figure 6); a midsole component

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2 defined by an inner midsole surface (that surface of 2 facing insole 1) and an outer midsole surface (that surface of 2 facing outsole 3); the midsole component extending to the sole middle portion and at least one sole side portion (see Figure 7); the sole surfaces of the sole defining a sole medial side, a sole lateral side and a sole middle portion located between these sides (see Figure 7, left, right and center portions); the outer midsole surface of one of the lateral and medial sides has a concavely rounded portion located in at least on shoe sole side and extending at least below a level of a lowest point of the midsole inner surface (see left or right side of midsole 2 in Figure 7); the concavity of the concavely rounded portion of the outer midsole surface existing with respect to an inner section of the midsole component directly adjacent to the concavely rounded portion of the outer midsole surface (see Figure 7); the inner midsole surface of the side of the shoe which has a concavely rounded portion of the outer midsole surface has a convexly rounded portion (see Figure 7); the convexity of the convexly rounded portion of the inner midsole surface existing with respect to a section of the midsole component directly adjacent to the convexly rounded portion of the inner midsole surface (Figure 7); a portion of a sole side located between the convexly rounded portion of the sole inner surface and the



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concavely rounded portion of the sole outer surface having a thickness that is greater than the thickness of the sole in the sole middle portion measured from the sole inner surface to the sole outer surface (Figure 7); the sole having a lateral side most section defined by that portion of the sole located outside a straight vertical line extending through the shoe sole at a lateral side most extent of the inner surface of the midsole component (shown in Figure 7 if vertical line is drawn); the sole having a medial side most section defined by that portion of the sole located outside a straight vertical line extending through the shoe sole at a medial side most extent of the inner surface of the midsole component (shown in Figure 7 if vertical line is drawn); at least part of the midsole component extends into the side most section of at least one shoe sole side (Figure 7); the part of the midsole component that extends into the side most section of the at least one shoe sole side further extends to above a lowermost point of the inner midsole surface of the midsole component on the same sole side (Figure 7); both the sole lateral and sole medial side portions comprise convexly rounded portion of the inner midsole surface portion and a concavely rounded portion of the outer midsole surface (see Figure 7); the concavely rounded portion of the outer midsole surface extends down to near a lowest point of the outer midsole

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surface of the midsole component which is located in one of the shoe sole sides (see Figure 7); the concavely rounded portion of the outer midsole surface extends through a side most extent of the outer midsole surface located in the same sole side (see Figure 7); the concavely rounded portion of the outer midsole surface extends down to near a lowest point of the outer midsole surface in one of the lateral and medial side most sections of the shoe sole sides (see Figure 7); the thickness between an inner midsole surface of the midsole part which extends into the side most section of the shoe sole side and an outer midsole surface of the midsole part which extends into the side most section of the shoe sole side increases from top to bottom (see Figure 7); the frontal plane cross-section is located in the heel area of the shoe sole (Figure 7 as described in the disclosure); the frontal plane cross-section is located in the forefoot area of the shoe sole (inasmuch as that which is shown or disclosed by the applicant); the concavely rounded portion of the outer midsole surface extends down near a lowermost point of the midsole component (see Figure 7); the concavely rounded portion of the outer midsole surface extends up to a level above the lowest point of the inner midsole surface of the midsole component (see Figure 7); the concavely rounded portion of the outer midsole surface extends from an uppermost portion of the

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shoe sole side to a level below the lowest point of the inner midsole surface (see Figure 7); the shoe is an athletic shoe (see Figures 6-7). JP '597 does not disclose the midsole having different firmnesses or densities and the location of the different densities within the midsole.

Norton et al. '402 teaches that a shoe with a midsole can have the midsole contain different densities (for portions 32, 34, 36), these different densities allowing for the foot to be more stable when placed in the shoe and contacting the ground. Norton et al. '402 further teaches that the higher density material can be located on the external sides of the midsole to aid in keeping the user's foot in the proper position when placed within the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the midsole of JP '597 out of multidensity material, such as that taught by Norton et al. '402, to aid in properly positioning the user's foot within the shoe and to aid in prevention supination or pronation of the user's foot during use. With respect to the limitations of claim 22, Norton et al. '402 discloses in col. 5, lines 34-59 and shows in Figure 7 the locations and use of a midsole of at least three densities. With respect to the limitations of claim 23, the same location in the specification of Norton et al. '402 as that applied to claim 22

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above discloses the locations and firmness of each different density material. Regarding the limitations of claim 26, Norton et al. '402 shows in Figure 7 that the midsole portions taper from the bottom of the shoe to the top, thereby meeting the limitations of this claim. With respect to claims 28-32 and 34, Norton et al. '402 shows the limitations of these claims in Figure 7, the first density being 36 and the second being either one of 32 or 34. With respect to claim 43, Norton et al. '402 describes that Figure 7 is taken in the heel area as shown in Figure 6 of Norton et al. '402. With respect to the limitations of claims 46-49, see col. 5, lines 34-59 and Figure 7 of Norton et al. '402 for the disclosure of these limitations.

#### ***Allowable Subject Matter***

9. Claims 35-36 and 45-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

#### ***Response to Arguments***

10. Applicant argues that the drawings (Figures 15A and 15D) show the forefoot region and therefore the drawings are proper. This argument is not clearly understood. Figures 15A and 15D show the forefoot region with only a sole and no midsole as originally claimed and therefore do not show all the claimed limitations. With respect to applicant's claims that the art applied in the rejections above do not show the midsole sides having a thickness greater than the thickness of the midsole in the middle portion, this argument is not clearly understood. As noted above, applicant went through great pains to distinguish the midsole from the sole and therefore, the shift from the sole to the midsole is impermissible. The references as applied do show the thickness greater in the sides than in the middle of the sole, as originally claimed.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
April 19, 2004